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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,911	08/18/2005	Ib Joergensen	31698-2030	4306

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LUCE, FORWARD, HAMILTON & SCRIPPS LLP
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EXAMINER

THANH, LOAN H

ART UNIT	PAPER NUMBER
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3763

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/511,911

Applicant(s)

JOERGENSEN ET AL.

Examiner

LoAn H. Thanh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS,, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-8, 13 and 21-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-6, 13 and 21-26 is/are rejected.
- 7) ☒ Claim(s) 7 and 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/16/07 has been entered.

Response to Amendment

The replacement drawing filed 11/14/06 has been approved. However, the drawing objection with respect to the coating is still maintained. Applicant needs to show this coating in the drawings and referenced with a reference numeral.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the coating (claims 13,23,26) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate

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prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-6, 21-22, 24-25 rejected under 35 U.S.C. 102(b) as being anticipated by Pinchuk (US 4,960,410).

Pinchuk discloses a balloon catheter having a concentric inflation and guidewire lumens. The guidewire tube (see figures 2-3,3a,3b) has proximal portion 60 and distal portion 64, wherein proximal portion 60 is made of stainless steel or metal and is more

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rigid than distal portion 64 which is made of plastic. The kink protection is considered to be element 62 where it is necked down. See column 3 lines 65- column 4, lines 11.

In another interpretation, the proximal portion is the thicker wall of 60, and the distal section is the thinner and scored wall. The sleeve encasing 64 is considered to be the transitional section.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13, 23, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pinchuk (US 4,960,410) in view of Wang et al. (US 5,951,494).

See Pinchuk above. Pinchuk discloses a dilatation balloon catheter. However, Pinchuk is silent to a coating of the surface. Wang discloses coating the metallic inner lumen of guidewire lumens in balloon catheter or catheters in general to provide smooth introduction of the guidewire into the lumen. It would have been obvious to one of ordinary skill in the catheter art at the time the invention was made to modify the balloon catheter of Pinchuk with a coating as taught by Wang in order to provide smooth, lubricious introduction of a guidewire into the lumen.

Allowable Subject Matter

Claims 7-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments with respect to claims 1,4-6,21-26 have been considered but are not persuasive because it appears that applicant is arguing more narrow than claimed. The examiner has showed each and every element. Applicant has claimed a "proximal portion comprises a more rigid material than the distal portion". The Examiner has shown that Pinchuk has a more rigid material at the proximal portion than the distal portion. Applicant has even argued that Pinchuk has a proximal portion which is more stiff than the distal portion and further the distal portion has increased flexibility. If a material is stiff at the proximal portion then it is safe to assume that it is also rigid. Stiff and rigid are synonyms. Applicant is directed to col. 3, lines 65 to col. 4, lines 11. Tube 60 and 64 are not necessarily made of only a single material as applicant has argued. Pinchuk discloses that tube 60 could be made of a stiff material (with a shore hardness of 80A and greater) and tube 64 can be made of a *more flexible material*. Further, claim 1 does not even require the materials to be different , but only to be a more rigid material than the other. For example, as applicant pointed out , the material is mechanically scored. As The Examiner has pointed , another broad interpretation

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could be the wall thickness. The thinner wall thickness can allow the tube to be more flexible than the thickness of the same material.

With respect to applicant's arguments that the sheath 64 covers only the portion the tube with the reduced outer diameter, the examiner is giving claim 5 the broadest reasonable interpretation. The sheath 64 does cover *part* of the proximal and distal portions.

With respect to claims 21-26, applicant appears to be arguing more narrow than claimed. Applicant has not claimed a guidewire tube with separate boreholes. Applicant has claimed a shaft comprising a pipe having a first and second borehole. Applicant's invention has a coaxial tube configuration and so does Pinchuk. Pinchuk has a lumen for the guidewire and a lumen for inflation.

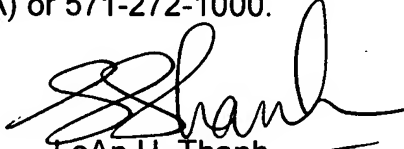
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LoAn H. Thanh whose telephone number is (571) 272-4966. The examiner can normally be reached on Mon. - Fri. (First Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Lucchesi can be reached on (571) 272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



LoAn H. Thanh
Primary Examiner
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LT